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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,780	10/20/2000	Arturo A. Rodriguez	A-6694	8562

5642 7590 01/15/2004

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	8

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,780	RODRIGUEZ ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 56-85 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 56-85 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 02 January 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,987) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 56-85 of this application. In particular, the examiner cannot find adequate support for the limitation wherein sequential data supplements are provided responsive to user in a manner that is synchronized with the video presentation.

2. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,520, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-2) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application wherein sequential data supplements are provided responsive to user in a manner that is synchronized with the video presentation does not appear to be disclosed in the parent application. Accordingly, the claims of the instant application shall be examined in view of the filing date of the instant application (19 October 2000).

Drawings

3. The replacement drawings for Figures 3, 4, 5, 7, and 10 were received on 2 January 2004. These drawings are approved.

Response to Arguments

4. Applicant's arguments and traversal of the OFFICIAL NOTICE with respect to the usage of a split-picture or picture-in-picture presentation of information has have been considered but is moot as all previously presented claims have been cancelled. A new grounds of rejection is presented as follows.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 56-61, 64, 66-71, 74, 76-81 and 84 are rejected under 35 U.S.C. 102(e) as being anticipated by Dodson et al. (US Pat No. 6,184,877).

In consideration of claim 56, the Dodson et al. reference discloses a method whereby a set-top terminal [102] is configured to receive a video presentation associated with multiple portions or programs from a "remote server" or cable provider headend. The method involves "providing a selectable option" [200/300/400] wherein upon "receiving viewer input from a viewer . . . to select the selectable option", the user may receive "a plurality of sequential data supplements" [400/500] that "corresponds to and is synchronized with the video presentation" such that the additional information is displayed in-synch or during the presentation and relates to or "corresponds to" to presentation (Col 3, Lines 8-28). Accordingly, "responsive to receiving the viewer input", the method meets the claimed

limitations wherein it "provides [a] plurality of sequential data supplements at a plurality of respective times corresponding to respective portions of the video presentation" [500] wherein each portion of the video presentation may correspond to a different program broadcast at a different time with corresponds to different respective "data supplement" associated with the program (Col 2, Line 59 – Col 3, Line 56).

Claim 66 is rejected as aforementioned in claim 56 wherein the set-top terminal [102] comprises a "processor" [108] coupled/connected to "memory" [110] that is "configured to store program code" (Col 5, Lines 53-59).

Claim 76 is rejected as aforementioned in claim 56 wherein the embodiment comprises the "receiving means for receiving viewer input from a viewer" [112] and "processing means for enabling the system" [108] to perform the aforementioned method.

Claims 57, 58, 67, 68, 77, and 78 are rejected wherein the "plurality of sequential data supplements comprise on-screen comments" such as those associated with the "director" (Col 3, Lines 50-56).

Claims 59, 69, and 79 are rejected wherein the "comments" comprise "comments from another viewer" such as the director or a movie reviewer (Col 3, Lines 50-56).

Claims 60, 61, 70, 71, 80, and 81 are rejected wherein as illustrated in Figure 5 the "supplemental data" comprises "textual data" that is displayed as "video data" on the user display [100].

Claims 64, 74, and 84 are rejected wherein "at least a portion of sequential data supplements and at least a portion of the video presentation are received substantially simultaneously by the STT" wherein the embodiment is operable to receive both the

television programming as well as retrieve the supplemental information from the Internet (Col 4, Line 42 – Col 5, Line 9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 62, 63, 65, 72, 73, 75, 82, 83, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodson et al. (US Pat No. 6,184,877).

In consideration of claims 62, 72, and 82, the Dodson et al. reference does not explicitly disclose nor preclude that the composition of television program information does not comprise "advertising". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the embodiment, if necessary, to further provide "advertising" as part of the information for the purpose of providing the user

with the opportunity to learn more about particular products/services featured and/or displayed during the television programming.

In consideration of claims 63, 73, and 83, the Dodson et al. reference does not explicitly disclose nor preclude that the "presentation" transmitted by the cable provider is a "video-on-demand presentation". Rather, the reference is not limiting with respect to the particular nature of the programming. Accordingly, it would have been obvious to one having ordinary skill in art at the time of the invention was made that the television program disclosed in the Dodson et al. reference may be that associated with a "video-on-demand presentation" or any other form of distributed television programming since it was known in the art that a "video-on-demand presentation" is particular distribution technique/method for the cable operators with which to distribute movie presentations. Furthermore, the particular usage of "video-on-demand" as a distribution means would advantageously provide the user with the added ability to further control the presentation of the television programming such that the user may pause the presentation while examining the "sequential data supplements".

In consideration of claims 65, 75, and 85, while the embodiment discloses the particular usage of an internet interface [106], the reference does not explicitly disclose nor preclude the composition of the interface. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Dodson et al. embodiment to utilize a cable modem as an internet interface [106] for the purposes of providing a means by which high speed access to internet content may be realized. Accordingly, the claimed limitation wherein "at least a portion of the plurality of sequential data supplements and at least a portion of the video presentation are received by the STT as part of a single data stream"

would be met by the modified embodiment as both the program and the supplemental information via the internet would be provided as a "single data stream" as distributed by the cable provider.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Birdwell et al. (US Pat No. 6,108,706) reference discloses a broadcast system wherein supplemental data is distributed and filtered according to user designated criteria.
- The Palmer et al. (US Pat No. 5,905,865) reference discloses a method and apparatus for connecting a computer to an electronic address delivered in sync with an audio/video broadcast wherein the information is presented in based on user selected options.
- The Wu et al. (US Pat No 6,326,982) reference discloses a client system and dedicated server that is operable to deliver supplemental information in a split-screen format in synchronization with a video presentation based on user selectable options.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
January 9, 2004

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600